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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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|------------------------|--------------------------|--------------------|
| In re: Application of: | Joseph Tesler            | Patent Application |
| Serial No.:            | 09/829,619               |                    |
| Art Unit:              | 2854                     |                    |
| Examiner:              | Daniel James Colilla     |                    |
| Filing Date:           | 4-10-2001                |                    |
| For:                   | Jewish Religious Scrolls |                    |
| Attorney Docket No.:   | 1481.007                 |                    |

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Commissioner for Patents  
P.O. Box 1450  
Arlington, Virginia 22313-1450

**Transmittal Letter**  
(8 pages total including this cover page)

Enclosed please find a Response to the Office Action of May 20, 2004, including a request for a three month extension of time. Authorization is hereby provided to charge all amounts due to Deposit Account No. 50-1604.

Dated: November 22, 2004

Respectfully submitted,



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CERTIFICATE OF MAILING (FACSIMILE TRANSMISSION)

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office (Technology Center 2800) at Facsimile Number 703-872-9318 on November 22, 2004.



Morris E. Cohen  
Transmission Date: November 22, 2004

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**Response to Office Action of May 20, 2004**

In response to the Office Action of May 20, 2004, enclosed please find the following:

**A Request for Continued Examination** begins on page 3 of this transmittal.

**Remarks** begin on page 4 of this transmittal.

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**Request for Continued Examination (RCE)**

Pursuant to 37 C.F.R. §1.114 and all applicable law, Applicant hereby requests continued examination of the application. The present request is believed to be proper since:

- (1) prosecution in the application is closed (i.e. the last Office Action was a final action);
- (2) a responsive submission is included herewith;
- (3) the fee set forth for an RCE is hereby provided (please charge all required fees to Deposit Account 50-1604);
- (4) and the present request is being submitted prior to abandonment of the application.

Accordingly, withdrawal of the finality of the Office Action and entry and consideration of the enclosed submission are hereby requested.

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### Response

Receipt is acknowledged of the Office Action dated May 20, 2004. A three month extension of the time provided for response and reconsideration of the application are respectfully requested. The Commissioner is hereby authorized to charge all fees due to Deposit Account No. 50-1604.

In the Office Action (page 7), the Examiner indicated his assumption that the actual name of G-d printed in the religious scroll includes the full spelling thereof. Applicant confirms that this is generally correct; however, Applicant would like to clarify that the full spelling is written on the scroll using the required Hebrew letters and not letters in English.

### Rejections under 35 U.S.C. §103(a)

In the Office Action, the claims of the application were rejected under §103(a) based on the combination of various references. Reconsideration of the rejection is respectfully requested.

It is respectfully submitted that the pending claims are not legally obvious over any of the references of record, whether considered individually or in combination. As set forth in the Manual of Patent Examining Procedure:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)."

See, M.P.E.P. §2143 (Eighth Edition 2001; May 2004 Revision).

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Under these requirements, it is respectfully submitted that the present invention is not and cannot be held to be obvious.

Claims 21-33

Silk screening is a relatively old process, which has been around for hundreds of years. The preparation of Jewish religious scrolls is even older, an ancient process which has been around for thousands of years. Thus, Applicant notes that there has been an extensive period of co-existence of the two methods.

Yet, not a single prior art reference has been found or cited by the Examiner teaching the preparation of Jewish religious scrolls using silk screening. Not even one prior art reference has been found which teach or suggests this in any manner. This very strongly demonstrates that the present invention is completely and thoroughly non-obvious.

Moreover, no reference has been found teaching or suggesting that such scrolls could be prepared using silk screening in a manner which comports with any of the stringent requirements of Orthodox Jewish law. This yet further indicates that the combination recited in the claims cannot be obvious.

For example, under Orthodox Jewish law, the creation of kosher Jewish religious scrolls requires the placement of large numbers of closely spaced Hebrew letters on animal parchment without a single letter ever coming into contact with its neighbor on even one religious scroll that is produced. In the case of a Torah scroll it is necessary that over 300,000 letters be placed onto parchment for each and every religious scroll, without even one single letter accidentally bleeding, spreading or extending

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sufficiently to produce an invalidating defect in the scroll.

However, printing using silk screening commonly results in an image which spreads slightly, as the ink is placed through the holes of the silk screen and absorbed into the substrate. It would be expected that a Hebrew letter placed onto parchment using silk screening would expand or spread slightly such that occasionally a portion of it could touch a neighboring letter above it or below it or to the left or right, particularly in view of the tight packing of letters and the extensions of the Hebrew letters above and below the line. *See e.g.*, Figure 2 of the application, line 3, the seventh letter from the right. Occasional minor events or contact of this sort are insignificant in normal printing. But this is totally unacceptable with respect to the printing of a religious scroll. If just one letter of the thousands required touches another, the entire scroll is completely invalidated. The nature of silk screening and this exceptionally stringent requirement of Jewish law therefore teach away from the combination of these methods to create a Jewish religious scroll.

Furthermore, no specific evidence of any sort appears to have been cited by the Examiner with respect to silk screening onto kosher parchment, which is a requirement of the claims. There is no evidence in the record that teaches or suggests that animal parchment could be silk screened at all. Nor is there any evidence that animal parchment could be silk screened in the precise manner needed which avoids spreading of letters.

Yet, the present inventor has nonetheless developed through considerable research a method which allows preparation of Jewish religious scrolls on animal parchment to the exacting standards required. None of the references cited teach this claimed invention, nor can the invention be deemed to have been obvious in view of the numerous unusual variables and issues that had to be overcome.

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Those problems were ultimately solved through applicant's inventive efforts, including, for example, his research relating to ink properties, his development efforts relating to silk screening onto animal parchment, and so forth. This further indicates that the present invention was not obvious.

In summary, no reference has been cited, and no suggestion or motivation has been shown in any of the references to produce the present invention – apart from applicant's own disclosure, which is legally impermissible. (See, citation in M.P.E.P. above). Secondly, there is no evidence of reasonable expectation of success; rather, the nature of the silk screening process would cause one to doubt the likelihood of success, and there is no evidence of any form which would support a reasonable expectation of success on animal parchment in particular. This is particularly a problem since many Hebrew letters in the text extend above the line, or below the line, very close to a neighbor, (as shown for example by the seventh letter from the right of the third line in applicant's Figure 2). Thirdly, even when combined, the references do not appear to suggest the required claim limitations. The Examiner does not appear to have cited any reference with respect to silk screen printing on animal parchment.

In view thereof, it is submitted that the subject matter of Claims 21-33 is thoroughly patentable.

#### Claims 1-12

Claims 1 - 12 are, in brief, directed to a method of preparing a Jewish religious scroll in which multiple letters are placed onto parchment with a single movement of the human hand, but without any two letters in the scroll coming into contact with each other (this being a common requirement of all of those claims, with the specific more detailed requirements of each of those claims being recited therein). Here too, the preparation of Jewish religious scrolls has been conducted for thousands of

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years, yet not a single prior art reference has been cited which teaches or suggests the subject matter of these claims in any manner. No references have been cited teaching or suggesting a means of preparing scrolls such as those recited by the claims. In view thereof, it is believed that these claims are completely and thoroughly non-obvious and patentable.

#### Conclusion

In view of the above, it is respectfully submitted that any findings of obviousness can only be in hindsight reconstruction which is impermissible. As a result, it is respectfully submitted that the pending claims are fully patentable over all of the art of record.

If the Examiner is considering any further rejections, it is requested that counsel be contacted before such a rejection so that an interview may be arranged to discuss the claims for the purpose of arriving at allowable subject matter.

Favorable action on all of the claims is respectfully requested and believed fully warranted.

Dated: November 22, 2004

Respectfully submitted,



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